

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Brian N. Tufte
 Serial No.: 10/811,670
 Filing Date: March 29, 2004
 For: LIGHTING APPARATUS
 Docket No.: 1076.1101110

Confirmation No.: 2974
 Examiner: Ismael Negron
 Group Art: 2875

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF Assistant Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450	CERTIFICATE OF ELECTRONIC TRANSMISSION I hereby certify that this paper is being electronically transmitted to the United States Patent and Trademark Office on the date shown below. <div style="display: flex; justify-content: space-between; align-items: center;"> <div style="text-align: center;">  _____ Lynn Thompson </div> <div style="text-align: center;"> July 27, 2007 _____ Date </div> </div>
--	--

Applicant submits that the Examiner's rejections set forth in the Final Office Action mailed May 1, 2007 contain at least the following clear errors and/or omissions of one or more essential elements needed for a *prima facie* rejection. Applicant hereby request review of the rejections prior to the filing of an appeal brief. Claims 1, 3-17, and 21-32 remain pending.

In paragraph 10 of the Final Office Action, the Examiner rejected claim 32 under 35 U.S.C. § 102(b) as being anticipated by BURKITT, III et al. In paragraph 12 of the Final Office Action, the Examiner states that “claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function” (emphasis original), citing *In re Schreiber*, 44 USPQ2d 1429. The Examiner also states that it has been held by the courts that apparatus claims cover what a device is, not what a device does, citing *Hewlett-Packard Co., v. Bausch & Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990). Because claim 32 recites elements in functional terms, the Examiner takes the position that the recited functional language can be ignored. Applicant believes this to be clear legal error.

Claim 32 is a “means -plus-function” claim specifically authorized by 35 U.S.C. § 112, sixth paragraph. Claim 32 recites, for example, elongated light source means for emitting light rays, and an elongated bumper means for carrying the elongated light source means and for providing a bumper function for a boat during normal use of the boat. 35 U.S.C. § 112, sixth paragraph, recites:

An element in a claim for a combination may be expressed as a means or

step for performing a specified function **without** the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(emphasis added). As can readily be seen, 35 U.S.C. § 112, sixth paragraph, specifically authorizes that an element of a claim may be expressed as a means for performing a specified function without the recital of structure, material or acts in support thereof. Because claim 32 falls within 35 U.S.C. § 112, sixth paragraph, it is clear legal error for the Examiner to ignore the functional language recited therein.

Notably, MPEP § 2181 states:

When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a “means or step plus function” limitation by giving it the “broadest reasonable interpretation.” Under the PTO’s long-standing practice this meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in *Donaldson*, the Federal Circuit stated:

Per our holding, the “broadest reasonable interpretation” that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

One skilled in the boat bumper art would clearly recognize that BURKITT, III et al. does not provide an elongated bumper means for carrying the elongated light source means and for providing a bumper function for a boat during normal use of the boat. BURKITT, III et al. discloses a fiber optic cable assembly that mounts to an inner perimeter surface of a swimming pool or a spa to providing lighting around the perimeter of the swimming pool or spa (see, BURKITT, III et al., abstract). This application appears to be merely ornamental, and does not appear to provide or require any “bumper” function at all, let alone “providing a bumper function for a boat during normal use of the boat”, as recited in claim 32. In fact, it is difficult to see any

need for a “bumper function” around the inside perimeter of a swimming pool or spa, as there would typically not be any objects in the swimming pool (e.g. people, inflatable inner tubes, etc.) that would require the swimming pool to include a bumper function around its inner perimeter.

Notably, when discussing durability, BURKITT, III et al. state: “[t]his arrangement also provides for increased durability and less likelihood that children will remove the tube from the track and damage the lighting system” (BURKITT, III et al., column 2, lines 43-46). As can be seen, and as far as durability is concerned, the types of things BURKITT, III et al. are worried about include children removing the tube from the track while playing in the swimming pool or spa, which is entirely different in scale from providing a bumper function for a boat during normal use of the boat, as recited in claim 32.

Nor is there anything in BURKITT, III et al. that would suggest that the fiber optic cable assembly of BURKITT, III et al. could provide a bumper function for a boat during normal use of the boat. In fact, given the apparent rather tenuous coupling between the tube and the track, with most of the tube outside of the track and having only the ends of the longitudinal members of the tube engaging certain limited parts of the L-shaped track (see Figure 2 of BURKITT, III et al.), it would appear that if the fiber optic cable assembly of BURKITT, III et al. were placed on a boat and subject to the kinds of abuse that a boat bumper is subject to during normal use, at a minimum the tube 14 would likely be pulled from the track 40, particularly since the kinds of abuse BURKITT, III et al. appears to be worried about include children removing the tube from the track while playing in the swimming pool or spa. Clearly, one skilled in the boat bumper art would not consider BURKITT, III et al. as being capable of providing a bumper function at all, let alone a bumper function for a boat during normal use of the boat, as recited in claim 32. For these and other reasons, claim 32 is believed to be clearly patentable over BURKITT, III et al.

In paragraph 6 of the Final Office Action, the Examiner rejected claims 12-14 under 35 U.S.C. § 102(b) as being anticipated by Gagne (U.S. Patent No. 5,499,170). As indicated in the advisory action dated July 10, 2007, the Amendment-After-Final will be entered for purposes of appeal. Claim 12 recites that the side walls of the light receiving cavity or lumen extend at least partially around to retain the elongated light source in place relative to the carrier even when the

insert is separated from the carrier. Gagne clearly does not teach, disclose or suggest a carrier having a light receiving cavity or lumen, wherein the side walls of the of the light receiving cavity or lumen extend at least partially around to retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier. The Examiner equates the carrier of claim 12 with the receptacle 50 of Gagne, and the light receiving cavity or lumen of claim 12 with the recess 65. However, the side walls of recess 65 of Gagne do not extend at least partially around to “retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier”, as recited in claim 12. Instead, and as acknowledged by the Examiner, Gagne teach to retain the elongated light source relative to the receptacle 50 using double sided tape 51, particularly when the protective top cover 70 is separated from the receptacle 50.

As noted in MPEP § 2231, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)”, and “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)” (emphasis added). Clearly, Gagne does not disclose, teach or suggest “each and every element” as set forth in the claims, or show the “identical invention” in as complete detail as is contained in the claims. As such, the Examiner’s 35 U.S.C. § 102(b) rejection of claims 12-14 is clear legal error and should be withdrawn.

In paragraph 8 of the Final Office Action, the Examiner rejected claim 15 under 35 U.S.C. § 102(b) as being anticipated by BURKITT, III et al. In paragraph 48 of the Final Office Action, the Examiner directs the Applicant’s attention to Figure 1 of BURKITT, III et al., where the Examiner asserts the elongated light source 12 is clearly shown filling or substantially filling the light receiving cavity or lumen 28. The Examiner states that it appears that Applicant mistakenly took BURKITT, III et al. exemplary showing of some of the optical fibers forming the whole of the elongated light source 12, as showing the true shape of such elongated light source.

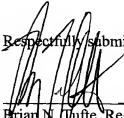
This interpretation of BURKITT, II et al. is believed to be clear legal error. Figure 1 of BURKITT, III et al. is a “perspective view of a partially-installed preferred fiber optic cable assembly according to the invention”. Figure 2 of BURKITT, III et al. provides a “cross-sectional view of the preferred fiber optic cable assembly taken about line 2-2 of FIG. 1”. Both Figure 1 and Figure 2 of BURKITT, III et al. show the SAME preferred fiber optic cable assembly. Figure 1 shows a perspective view of the entire system, and Figure 2 shows a detailed view of the preferred fiber optic cable assembly of Figure 1 taken along line 2-2. One skilled in the art would clearly understand this.

The Examiner asserts that because the system level figure (Figure 1) does not explicitly show a space between the elongated light source 12 and the light receiving cavity or lumen 28, that no space exists, despite having Figure 2, which clearly shows additional detail of the same preferred fiber optic cable assembly of Figure 1, and more specifically, that the bundle of fiber optic 12 only occupies about 55% of the cross-sectional area of the internal longitudinal passageway 28. It is clear legal error to attempt to use a more general figure to argue a feature does not exist (i.e. a gap), when a more detailed figure for the same embodiments exists and clearly shows that the feature (i.e. the gap) is present. Moreover, during a phone interview on June 28, 2007, the Examiner acknowledged that there MUST be at least some gap in order to initially insert the fiber optic cable into the assembly.

The errors made with respect to the remaining rejections contained in the Final Office Actions are fully addressed in the Amendment-After-Final filed June 29, 2007, which is incorporated herein by reference.

Respectfully submitted,

Dated: July 27, 2007



Brian N. Tufte, Reg. No. 38,638
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2402
Telephone: (612) 677-9050
Facsimile: (612) 359-9349